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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,513	09/22/2000	Masaya Kimura	826.1625/JDH	9866

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EXAMINER

SWICKHAMER, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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2662

DATE MAILED: 12/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,513

Applicant(s)

KIMURA ET AL.

Examiner

Christopher M Swickhamer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 10/19/00 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

2. The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. The language used is not consistent with proper idiomatic English and does not allow the Examiner to clearly understand the invention and the functionality of the individual devices. These problems could arise from the translation the document

- Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

- Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

- A shortened statutory period for reply to this action is set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter.

- A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

- Referring to claims 1-3, 5, 7-11 and 13-17, the “relay device” is not described in such a manner to enable one of ordinary skill in the art to reproduce this invention. For example, in figure 1 the device appears to be shown in a network. This lends itself to interpreting the device to be a router. However, in figure 33, the relay device is shown directly connected to the receiving terminal. This lends itself to interpreting the device to be an external hard drive. The Examiner believes that the specification does not give an adequate written description of the relay device to allow one of ordinary skill in the art to understand and reproduce this invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- Claim 6 recites the limitation "the same contents" in line 4. There is insufficient antecedent basis for this limitation in the claim.

- Referring to claims 1-17, the specification and claims are not written in such a manner to allow a meaningful search of all claims. The specification does not describe all devices listed in the claims to give an adequate understanding of the invention to search the claimed subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 5, 6, 14, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim (USP 6,546,002).

- Referring to claim 1 as best understood by the Examiner, Kim discloses a method of delivering resources used in a system where there are a plurality of MIA clients (relay devices) between a delivering source device which delivers resources (such as a licensed program/service, col. 12, lns. 8-27) and a terminal device which receives the resources (PC, MAC, cellular telephone, Fig. 1 and 8), comprising: notifying from the terminal device to the delivering source device of information specifying resources to be delivered and a MIA client (relay device) for receiving the resources (col. 4, lns. 40-60); delivering the resources specified by the notification

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from the delivering source device to the relay device specified by the notification; and delivering the resources from the relay device to the terminal device according to an access from the terminal device (col. 11, lns. 40-col. 12, lns. 27).

- Referring to claim 2 as best understood by the Examiner, Kim discloses a method of delivering resources used in a system where there are a plurality of MIA clients (relay devices) between a delivering source device which delivers resources and a terminal device (PC, PDA, cellular phone, MAC) which receives the resources, comprising: notifying from the terminal device to the delivering source device of information specifying a relay device for receiving resources from the delivering source device; delivering resources from the delivering source device to the relay device specified by the notification; and delivering the resources from the relay device to the terminal device according to an access from the terminal device (Fig. 1, 6 and 8, col. 4, lns. 40-60, col. 11, lns. 40-col. 12, lns. 27).

- Referring to claim 5 as best understood by the Examiner, Kim discloses a method of delivering resources used in a system where there are a plurality of relay devices between a delivering source device which delivers resources and a terminal device which receives the resources, comprising: notifying from a first terminal device to the delivering source device of information specifying a MIA client (relay device) for receiving resources from the delivering source device; delivering resources from the delivering source device to the MIA client (relay device) specified by the notification; delivering the resources from the MIA client (relay device) to the first terminal device (PC) according to an access from the first terminal device (PC); and delivering the resources from the relay device to a second terminal device (MAC) according to

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an access from the second terminal device (Fig. 1, 6 and 8, col. 4, lns. 40-60, col. 11, lns. 40-col. 12, lns. 27).

- Referring to claim 6 as best understood by the Examiner, Kim discloses the method according to claim 5, wherein the delivering source device does not deliver resources to the relay device when a notification that the profile data does not need to be updated (of the same contents is received, col. 11, lns. 45-65).

- Referring to claim 14 as best understood by the Examiner, Kim discloses a resource delivering apparatus which delivers resources at a request from a terminal device, comprising: an analysis unit receiving information from the terminal device and analyzing it, the information specifying a MIA client (relay device) which can be accessed by the terminal device; and a delivering unit delivering resources to a MIA client (relay device) specified by the information based on the analysis result obtained by said analysis unit (Fig. 1, 6 and 8, col. 4, lns. 40-60, col. 11, lns. 40-col. 12, lns. 27).

- Referring to claim 16 as best understood by the Examiner, Kim discloses a computer-readable storage medium storing a program to be executed by a computer used in a system where there are a plurality of relay devices between a delivering source device which delivers resources and a terminal device which receives the resources, comprising: a first program code receiving information from the terminal device and analyzing it, the information specifying a relay device which can be accessed by the terminal device; and a second program code delivering resources to a relay device specified by the information (Fig. 1, 6 and 8, col. 4, lns. 40-60, col. 11, lns. 40-col. 12, lns. 27).

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- Referring to claim 17 as best understood by the Examiner, Kim discloses a computer-readable storage medium storing a program to be executed by a computer used in a system where there are a plurality of relay devices between a delivering source device which delivers resources and a terminal device which receives the resources, comprising: a first program code receiving information specifying resources to be delivered from the terminal device; a second program code accessing a delivering source device which provides resources specified by the information, and obtaining the resources; a third program code delivering the resources to another relay device; and a fourth program code delivering the resources to the terminal device according to an access from the terminal device (Fig. 1, 6 and 8, col. 4, lns. 40-60, col. 11, lns. 40-col. 12, lns. 27).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M Swickhamer whose telephone number is (703) 306.4820. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (703) 305-4744. The fax phone number for the organization where this application or proceeding is assigned is (703) 872.9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305.3900.

CMS
November 18, 2003

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